



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/650,605	08/30/2000	Gilma A. Z. Perkins	MSFT-0166/144193.1	9087
41505	7590	11/17/2004	EXAMINER	
WOODCOCK WASHBURN LLP ONE LIBERTY PLACE - 46TH FLOOR PHILADELPHIA, PA 19103			ALVAREZ, RAQUEL	
			ART UNIT	PAPER NUMBER

3622

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/650,605

Applicant(s)

PERKINS ET AL.

Examiner

Raquel Alvarez

Art Unit

3622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 and 20-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 20-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This office action is in response communication filed on 8/30/2004.
2. Claims 1, 5, 6, and 20 have been amended. Claims 11-19 have been canceled. Claims 21-27 have been added.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Titles displayed according to a national scope, and prompting the user to select a rotation scope, wherein said rotation scope defines a display frequency and one or more geographic areas.

### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3622

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-10 and 20 rejected under 35 U.S.C. 102(e) as being anticipated by Leal (6,189,003 hereinafter Leal).

With respect to claims 1-2, 5, and 20 Leal teaches a method of registering business directory listing and advertisements (Abstract). Providing a computer-based directory of business listings and advertisements comprising a tree having editorial nodes having labels representative of business categories, said leaf level editorial nodes having SIC base business listings associated therewith, said business directory capable of storing business listings according to said business categories (i.e. classifying and storing business listings according to a main category, for example, Home and Garden with branching subcategories, for example, carpet cleaner)(col. 3, lines 3-20 and col. 8, lines 65- to col. 9, line 15); accepting from a client, via a network at least one request to store a desired business listing (col. 4, lines 30-35); and storing said business listing according to said business categories for association with said desired business listing(col. 4, lines 30-35 and col. 9, lines 2-15).

With respect to claims 3-4, Leal further teaches that said business listings and advertisements reside in a data store having a plurality of tables that define the display of said business directory listing (see Figure 8).

With respect to claims 6-9, Leal teaches a system for the registration of business directory listing and advertisements (Abstract). A registration engine, said registration engine having a set of adaptable instructions stored on a computer readable medium to procure and format business directory listing data in accordance to a predefined set of business categories, said business categories indicative of a editorial nodes of a data business data taxonomy tree (i.e. classifying and storing business listings according to a main category, for example, Home and Garden with branching subcategories, for example, carpet cleaner)(col. 3, lines 3-20 and col. 8, lines 65- to col. 9, line 15); a business directory listing data store storing advertisements and said business directory listing data according to said business categories and cooperating with said registration engine to accept, maintain and retrieve business directory listing data for display (See Figure 8).

With respect to claim 10, Leal further teaches that the registration engine comprises a business directory listing server running registration computing application and connected to the Internet (See Figures 3-4).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3622

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leal.

Claims 21, 25 and 27 further recite well known information necessary to advertise a product or service. Since Leal teaches advertising a product or service then it would have been obvious to obtain certain information such as the package description desired, the number of lines desired, the text to be printed, the color desired and image for the titles, the advertisement packages containing graphical image banners in order to customize the ad to the individual needs. It would have been obvious to person of ordinary skill in the art at the time of Applicant's invention to have included the above steps necessary to create an advertisements in order to obtain the above mentioned advantage.

Claim 26 further recites displaying the ads according to a particular rotation scope which defines a display frequency one or more geographic areas. Relating and rotating a particular ad to one or more geographic area is obvious and well known in order to associate an ad with a redemption location. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included displaying the ads according to a particular rotation scope which defines a display frequency one or more geographic areas in order to obtain the above mentioned advantage.

With respect to claim 22, Leal further teaches prompting the user to enter e-mail address.(see Figure 8).

With respect to claims 23-24, Leal further teaches a hyperlink to the user's content (col. 10, lines 15-24).

### **Response to Arguments**

8. The 101 rejection has been withdrawn.
9. Applicant argues that Leal doesn't teach registering business listing and advertisements. The Examiner respectfully disagrees with Applicant because Leal clearly teaches on col. 3, lines 3-10, "Each individual business can promote itself via an electronic template that displays a uniform set of criteria for each business category. ....(eg...specialty services, hours of operation, **special promotions, etc.)**". In addition Leal teaches on col. 7, lines 1-5 " Each listing 44 may be enhanced by incorporating the business' attributes they wish to promote". Also, Leal teaches on col. 10, lines 23-24, providing Internet coupons in addition to the company listings.
10. The Examiner asserts that Leal teaches the claimed invention.

### **Conclusion**

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Point of contact**

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Raquel Alvarez  
Primary Examiner

Application/Control Number: 09/650,605

Page 8

Art Unit: 3622

Art Unit 3622

R.A.

11/15/04